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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,737	04/13/2001	Satoshi Shimbori	Q64078	2879
7590 11/08/2004 SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20037-3213			EXAMINER SINGH, SATWANT K	
			ART UNIT 2626	PAPER NUMBER

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/833,737

Applicant(s)

SHIMBORI ET AL.

Examiner

Satwant K. Singh

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-16 is/are rejected.
- 7) ☐ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 11, 12, 14 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Gacek (US 6,795,205).
3. Regarding Claim 1 Gacek discloses a printing system for printing information received by a user via the Internet, comprising: an information sending apparatus (third-party merchant 302) operable to provide information via the Internet; a terminal unit for receiving said information (set-top box 322) provided by said information sending apparatus and operable to print said information with a printer (printer of home user 320); and a printing managing apparatus (intermediary services 305) operable to obtain a printing cost for printing said information by said printer and to compensate a user for said printing cost (present invention allows the home user to demand compensation for allowing such print jobs to be push-printed to the home user's printer) (col. 9, lines 8-16), said printing managing apparatus compensating a user for said printing cost by charging said printing cost to said information sending apparatus (payment tendered by third-party merchant), and said printing managing apparatus charging said printing cost

to said information sending apparatus by means of a point having substantially the same value as said printing cost, said point being usable on the Internet (The payment which was tendered by third-party merchant 302 to intermediary service 305 during negotiations is then resolved with home user 320, thereby compensating home user 320 for the printer-related consumables, such as ink and paper, which are utilized by printer 324 during printing of the print job.) (col. 13, lines 4-30).

4. Regarding Claim 2 Gacek discloses a printing system wherein said information provided by said information providing system is an advertisement, and said point is provided when said advertisement is printed (The payment may instead be provided to home user 320 in the form of vouchers and/or coupons for purchasing printer-related consumables such as ink and paper) (col. 13, lines 23-26).

5. Regarding Claim 3 Gacek discloses a printing system wherein said point is electronic money (In another embodiment, the payment may be added as a credit to home user 320's digital cable network subscription account. In another embodiment, the payment may be credited to the home user in the form of "internet money" which is commonly referred to as "beans") (col. 13, lines 20-23).

6. Regarding Claim 4 Gacek discloses a printing system wherein said point is applied as payment to replenish consumable items of said printer The payment may instead be provided to home user 320 in the form of vouchers and/or coupons for purchasing printer-related consumables such as ink and paper) (col. 13, lines 23-26).

7. Regarding Claim 11 Gacek discloses a printing system wherein said terminal unit is operable to print information other than said information for which said printing cost is

compensated (In step S804, the home user provides preferences regarding the push-print service by identifying the third parties from which push-print jobs will always be allowed by the home user for printing on a printer of the home user. In this manner, the home user can identify certain third parties which can always send print jobs for printing on a printer of the home user without the need for prior authorization by an intermediary service.) (col. 17 lines 49-57), and to select whether or not said other information is added to said information for which said printing cost is compensated (Intermediary services 305 makes this determination by checking information which was previously provided by home user 320 regarding the types of third-party internet applications that home user 320 will allow to send print jobs, if any, and regarding the compensation required by home user 320 for allowing such print jobs to be sent.) (col. 13, lines 40-58).

8. Regarding Claim 12 Gacek discloses a printing system wherein said printing managing apparatus includes an identifying-information providing unit (look-up service 304) operable to add a user ID (identification information for home user 304) for specifying a user of said terminal unit and printing identifying information, which specifies the contents of said information, to said information (third-party merchant 302 provides the identification information regarding home user 320 to look-up service 304 in a query to obtain the appropriate intermediary service) (col. 11, lines 18-32), said printer prints said user ID and said printing identifying information as well as said information (authorization to push a print job to the home user's printer) (col. 11, lines , and said printing managing apparatus obtains said user ID and said printing identifying information via the Internet to record said user ID and said printing identifying

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information therein (look-up service 304 provides third-party merchant 302 with identification information regarding the appropriate intermediary service) (col. 11, lines 33-49).

9. Regarding Claim 14, Gacek teaches a printing system wherein said printing managing apparatus includes a printing history database having a printing history for each user (print queue) (STB 322 has the capability to retain the print job in the local spooler of STB 322, (CPSI spooler 26, FIG. 2), whereupon the home user can subsequently view the print job and/or send the print job to printer 324 for printing) (col. 15, lines 46-64), and restricts a number of sheets printed in a predetermined period for a user so as not to exceed a predetermined limit (capabilities of printer) (home user 320 allows the print job to be sent to a printer of home user 320 (step S503), then flow passes to step S504 in which intermediary service 305 provides information regarding the types of printers which are made available by home user 320 for printing print jobs, and the corresponding printing options and capabilities of the available printers) (col. 13, lines 59-64).

10. Claim 16 is rejected for the same reason as claim 1.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 5, 6, 8-10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeung et al. (US 6,690,481) in view of Gacek (US 6,795,205).

13. Regarding Claim 5, Gacek teaches printing system.

Gacek fails to teach a printing system wherein said printer includes a print certifying unit operable to issue an electronic certificate for certifying that said printer has printed said information satisfactorily, and said printing managing apparatus includes a point certifying unit operable to certify said electronic certificate issued by said print certifying unit.

Yeung et al teach a printing system wherein said printer includes a print certifying unit operable to issue an electronic certificate for certifying that said printer has printed said information satisfactorily, and said printing managing apparatus includes a point certifying unit operable to certify said electronic certificate issued by said print certifying unit (the notification client at the set top box notifies the cable head end as each sheet of the print job is commenced, as each sheet is concluded, and as the print job is concluded) (col. 12, lines 26-60).

Therefore, it would have been obvious to one of ordinary skill in the art to have combined the teachings of Gacek with the teaching of Yeung to utilize the print status information so as to monitor and manage the print queues of the set top boxes.

14. Regarding Claim 6, Gacek teaches a printing system wherein said print certifying unit encrypts said electronic certificate, and said point certifying unit decrypts said encrypted electronic certificate (intermediary services utilize secure connections over the internet) (col. 10, lines 29-34).

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15. Regarding Claim 8, Gacek teaches a printing system.

Gacek fails to teach a printing system wherein said printer includes a printing monitoring unit operable to monitor whether or not said printing of said information has been finished satisfactorily, and said print certifying unit issues said electronic certificate when said printing monitoring unit determines that said printing of said information has been finished satisfactorily.

Yeung et al teach a printing system wherein said printer includes a printing monitoring unit operable to monitor whether or not said printing of said information has been finished satisfactorily, and said print certifying unit issues said electronic certificate when said printing monitoring unit determines that said printing of said information has been finished satisfactorily (the notification client at the set top box notifies the cable head end as each sheet of the print job is commenced, as each sheet is concluded, and as the print job is concluded) (col. 12, lines 26-60).

Therefore, it would have been obvious to one of ordinary skill in the art to have combined the teachings of Gacek with the teaching of Yeung to utilize the print status information so as to monitor and manage the print queues of the set top boxes.

16. Regarding Claim 9, Gacek teaches a printing system wherein said printing monitoring unit detects a type of paper to be used for said printing, and said print certifying unit issues said electronic certificate when said printing monitoring unit determines that said type of paper is a predetermined type of paper (print options are obtained by third-party merchant 302 which then decides which printer and which print options are appropriate for the print job) (col. 13, lines 59-67, col. 14, lines 1-18).



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17. Regarding Claim 10, Gacek teaches a printing system wherein said printing managing apparatus includes a user database with a printing environment of said printer stored for each user, and said print certifying unit issues said electronic certificate when said printing monitoring unit determines that said type of paper is a type of paper registered in said user database (intermediary service 305 provides information regarding the types of printers which are made available by home user 320 for printing print jobs, and the corresponding printing options and capabilities of the available printers) (col. 13, lines 59-67, col. 14, lines 1-18).

18. Regarding Claim 13, Gacek teaches a printing system wherein said printing managing apparatus includes a user database in which a printing environment of said printer is stored for each user and a printing cost calculating unit operable to calculate said printing cost based on the contents of said user database and said electronic certificate (intermediary service 305 then returns a quoted price to third-party merchant 302 for the print job based upon the number of pages, type of paper, and other print job request parameters (step S506))(col. 14, lines 11-20).

19. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sekizawa (US 6,430,711) in view of Gacek (US 6,795,205).

20. Regarding Claim 15, Gacek teaches a printing system wherein said point is applicable as payment for said ordered consumable items (the payment may instead be provided to home user 320 in the form of vouchers and/or coupons for purchasing printer-related consumables such as ink and paper) (col. 13, lines 22-25).

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Gacek fails to teach a printing system further comprising a consumable ordering apparatus operable to make said terminal unit find a remaining amount of consumable items of said printer and to place an order for said consumable items based on said remaining amount of said consumable items.

Sekizawa teaches a printing system further comprising a consumable ordering apparatus operable to make said terminal unit find a remaining amount of consumable items of said printer (the local information getting section 11) (col. 20, lines 51-57) and to place an order for said consumable items based on said remaining amount of said consumable items (conversion-to-electronic-mail section 13a) (col. 20, lines 61-67, col. 21, lines 1-6).

Therefore it would have been obvious to one of ordinary skill in the art to combine the teachings of Gacek with the teachings of Sekizawa to automatically order consumable via email as an to replenish consumable items for the printer when supplies begin to run low.

***Allowable Subject Matter***

21. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (703)

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306-3430. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Satwant Singh*

sks

Satwant K. Singh  
Examiner  
Art Unit 2626

*KA Williams*

KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER